



Serial No. 10/645,868

Docket No.: 1293.1857

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jong-hoon LEE, et al.

Serial No. 10/645,868

Group Art Unit: 2627

Confirmation No. 8642

Filed: August 22, 2003

Examiner: Christopher Ray Lamb

For: METHOD OF CONTROLLING RECORDING OPERATION FOR OPTICAL DISC
RECORDING APPARATUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attention: **MAIL STOP AF**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

This is a "pre-appeal brief request for review" filed concurrently with a Notice of Appeal appealing final rejection of claims 1-8, 10-13, 15, 16, 18 and 19 in the October 30, 2008 Final Office Action (hereinafter "Office Action"). A Petition for a One Month Extension of Time, together with the requisite fee, is enclosed, thereby extending the response due date to February 28, 2009.

A pre-appeal brief panel review of below appealable issues I, II and III is requested:

I. The Office Action rejection of claims 1-8, 10-13, 15, 16, 18 and 19 over Takasago in view of Kamiyama and further in view of Nakane and further in view of Kishimoto is clearly improper, because the Office Action errs by improperly alleging that Kishimoto overcomes deficiencies in the remaining references. Thus, the prior art references do not teach or suggest all the claim limitations, as required by M.P.E.P. 2143.

Independent claim 1 (used as an example herein) recites comparing the length of the defect with first and second times "determined according to a recording speed of the optical disc." The Office Action indicates that the primary reference (Takasago) and secondary references (Kamiyama/Nakane) do not teach these features. Instead, the Office Action relies on Kishimoto. Specifically, the Office Action (page 5, lines 1-2) states "Kishimoto discloses that an optical disc apparatus may have a plurality of different speeds."

However, a plurality of different speeds is not the same as the claimed feature, which is comparing of the length with the times being "determined according to a recording speed of the disc." Thus, even assuming, *arguendo*, that Kishimoto does teach a plurality of different speeds, Kishimoto still does not overcome the deficiencies in the remaining references. Thus, on its face, the Office Action is deficient for failing to address all claim features.

While Kishimoto may teach different speeds, the Office Action does not allege that Kishimoto teaches how to determine length and times according to the variable speed that is being used.

M.P.E.P. 2143 requires the prior art references to teach or suggest all the claim limitations. Thus, the final Office Action rejections are clearly improper for failing to address all claimed features.

II. The Office Action rejection of claims 1-8, 10-13, 15, 16, 18 and 19 is also clearly improper, because the Office Action errs by improperly alleging that Takasago teaches the suggestion or motivation to combine the references, as required by M.P.E.P. 2143.

The Office Action indicates the Takasago/Kamiyama/Nakane combination does not teach the claimed "comparing the length of the defect with first and second times determined according to a recording speed of the optical disc." Instead, the Office Action relies upon Kishimoto. In establishing motivation, the Office Action uses a three-step reasoning. First, the Office Action alleges that Kishimoto discloses that an optical disc may have a plurality of different speeds, and then alleges that it would have been obvious to modify Takasago/Kamiyama/Nakane to record at different speeds. Finally, the Office Action concludes by saying "the motivation would have been to record at a higher and/or more appropriate speed." Office Action, page 5, lines 1-16.

It is emphasized that the Office Action relies upon Kishimoto as teaching the use of *variable* speeds. Thus, the addition of the Kishimoto reference modifies Takasago/Kamiyama/Nakane from fixed speed to variable speed. However, the purported motivation (higher and/or more appropriate speed) could have been achieved without the use of variable speeds. A higher speed would not have to have been a variable speed. Instead, the higher speed could have been a *fixed* higher speed. Similarly, this "more appropriate speed" could have also been a *fixed* speed.

The Response to Arguments portion of the Office Action states "the most appropriate speed is not necessarily the highest one." However, Applicants respectfully note that a variable

speed device would not have been necessary to achieve the most appropriate speed. Instead, the fixed speed may also have been the most appropriate speed for the circumstances.

M.P.E.P. 2143 requires the suggestion or motivation to combine the references. Thus, the final Office Action rejections are clearly improper for failing to provide proper motivation, as discussed above.

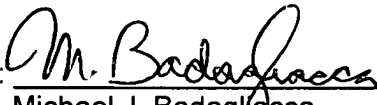
III. The Office Action rejection of claims 1-8, 10-13, 15, 16, 18 and 19 over Takasago in view of Kamiyama and further in view of Nakane and further in view of Kishimoto is clearly improper, because the Office Action errs by improperly alleging that Takasago discloses determining a type of the defect based on the length of the defect.

Independent claim 1 recites determining a type of the defect based on the length of the defect. In contrast, the defect is classified according to the duration of the off-track signal in Takasago. Takasago, col. 3, ln. 30-31. A factor in this distinction is that Takasago is directed to detecting an external disturbance causing the off-track. Takasago, col. 3, ln. 4-6. In contrast, the present invention may be used to detect dirt, dust, scratches or disk manufacturing errors causing off track. Present paragraph 18. Takasago cannot classify errors caused by these factors. If time T_1 of Takasago is not exceeded, normal recording/reproducing is determined. Because the duration T_1 is determined so that an external disturbance may be detected, this time is too long to detect errors caused by dirt and dust.

Withdrawal of the rejection of pending claims is respectfully requested. If there are additional fees associated with this filing, please charge same to Deposit Account No. 19-3935.

Respectfully submitted,
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Date: 3-2-09

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